REMARKS

This is intended as a full and complete response to the Office Action dated January 29, 2007, having a shortened statutory period for response set to expire on April 29, 2007. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1, 3, 5-9, 13-21, 24-26, and 28-61 remain pending in the application after entry of this response. Claims 1, 8, 13, 18, 24, 34, 40, and 45 have been amended and new claims 46-61 have been added. No new matter has been added by either the amendments or new claims. Claims 1, 3, 5-9, 13-21, 24-26, and 28-45 are rejected by the Examiner.

Claim Rejections Under 35 USC § 102

Claims 1, 3, 5-9, 13-21, 24, 25, and 28-34 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by *Galle* (US 2003/0178847). *Galle* does not teach, suggest, or disclose a method, comprising "determining acceptability of the threaded connection", as recited in amended claim 1 or a computer configured to perform an operation, comprising "determining acceptability of the threaded connection", as recited in amended claim 24. *Galle* is completely silent regarding even the possibility of a bad connection. Therefore, claims 1, 24, and their dependents are not anticipated by *Galle*.

Claim Rejections Under 35 USC § 103

Claims 1, 3, 5-9, 13-21, 24, 25, and 28-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Vincent* (US Re. 34,063) in view of *Galle*. Applicants respectfully traverse the rejection.

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP §2141.02 VI. (emphasis in original). Contrary to the Examiner's assertion that "[o]bvoiusness may exist although teachings relied upon may be disclosed in the art as ... unsatisfactory for the intended purpose", the MPEP provides: "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is

no suggestion or motivation to make the proposed modification." MPEP §2143.01 V. (emphasis added; see also §2143.01 VI.). Applicants also note that *In re Boe* was later distinguished by *In re Braat*, 918 F.2d 185; 16 U.S.P.Q.2D (BNA) 1812 (Fed. Cir. 1990):

> The Board cited *In re Boe*, as noted above, to support its obviousness rejection. In that case, however, the suggestion of practicing the claimed invention in a particular way was more of an embodiment than a teaching away. 355 F.2d at 963, 148 USPQ at 509 ("the pore-forming materials can be added with the latice-forming [sic] materials") (emphasis added). Here, Uehara strongly suggests not to unite the glass and elastic lenses.

Vincent unmistakably teaches away from a torque-turn approach disclosed by *Galle* by stating:

> With the present invention, applicants have determined that the prior tubular goods torque monitoring techniques, with the acceptability-nonacceptability criteria being based on the interrelationship between the torque sensed and the number of turns made during make-up, are unacceptable. Specifically, since a shoulder condition can be achieved in a smaller portion of a turn of the connection than that usually sensed in torque-turn monitoring, the prior torque-turns technique and philosophy are substantially unsuitable for premium threaded connections.

(Col. 5, lines 15-26, emphasis added; see also col. 2, lines 3-9). Further, *Vincent* repeatedly makes it crystal clear that his disclosure is confined only to a torque-time approach and his disclosure does not include a torque-turns approach as an alternative embodiment (Abstract; col. 2, lines 3-9; col. 4, lines 63-67; col. 5, lines 15-33; col. 6, lines 33-56; col. 9, lines 32-41; col. 11, lines 44-52; col. 12, lines 30-34; and FIGS. 2-6) In fact, Vincent does not even provide a turns detector in his apparatus A (col. 3, line 36-col. 5, line 13). Further, as discussed above, *Galle* does not provide any motivation to combine as *Galle* is completely silent regarding bad connections. Therefore, neither *Vincent* nor *Galle* provides any motivation to combine with the other and, certainly, none that would overcome the enormous weight of *Vincent*'s teaching away. Withdrawal of the rejection is respectfully requested.

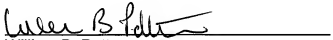
Claims 26, 36-39, and 40-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Vincent* in view of *Galle* as applied to claim 24 above, and further in view of *Bromell* (US 3,662,842) or *Juhasz* (US 6,443,241). As discussed above, the

combination of *Vincent* and *Galle* is improper. Withdrawal of the rejection is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



William B. Patterson
Registration No. 34,102
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicant(s)